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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,633	12/07/2001	Oskar Wack	00-07300US	3352

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EXAMINER

CARRILLO, BIBI SHARIDAN

ART UNIT PAPER NUMBER

1746

DATE MAILED: 10/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/008,633

Applicant(s)

WACK, OSKAR

Examiner

Sharidan Carrillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on IDS filed 6/18/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a) a first component being water, b) a second component being an organic component having lipophilic and hydrophilic groups, c) objects selected from the group consisting of metal, glass, ceramic, or plastic (p. 1, lines 7-9), and conditions selected from the group consisting of temperature, pressure, ultrasound (p. 6, lines 14-17) does not reasonably provide enablement for any type of component, any type of object, and any type of condition. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The claims embrace an invention which contains any known component, object and condition, which could/can be selected from literally thousands. It does not appear feasible that any component, object, and condition would function in the present invention in order to form a solubility gap. Further, for one skilled in the art to reproduce the present invention (which must be possible, if the specification is adequate), there would clearly be undue experimentation to do so in an attempt to figure out which component, object and condition would work and which ones would not.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is indefinite because it is unclear what one of ordinary skill in the art would consider as the first and second conditions necessary to form a solubility gap and a mixture. Specifically, what are the first and second conditions. Claim 8 is further indefinite because it is unclear whether the objects are cleaned using the second designated conditions. Claim 11 is indefinite because it is unclear how the cleaning liquid can form a two-phase during the second designated conditions, since the second designated conditions results in a mixture. Claim 11 is further indefinite because it is unclear what is meant by "having a continuous aqueous phase with droplets of an organic-rich phase". It is also unclear whether the aqueous phase and the organ rich phase pertains to the first component being water and the second component being the organic component. Additionally, if the aqueous phase contains organic droplets, it is unclear how the aqueous phase can be continuous. Claim 13 is indefinite because it recites multiple temperatures for both the first and second set of designated conditions, the limitations of which lack positive antecedent basis. Claim 14 is indefinite because it is unclear what is meant by "effected by" at least one of separation and filtration. It is unclear whether applicant intends separating contaminants by filtration.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 8-14 are rejected under 35 U.S.C. 102(b) as being anticipated by DE19908434A1.

Pages 1-2 of the instant specification describes the teachings of DE19908434A1. Specifically, the reference teaches a method for cleaning objects in which the objects to be cleaned are brought into contact with a cleaning liquid that has an organic solvent and water. Contaminants are deposited onto the surface of the cleaning liquid from where it is removed. On pages 2-3 bridging, the specification teaches that prior art of DE19908434A1 recognizes that cleaning liquids having at least two components clean particularly efficiently if the two components, under certain first conditions, for example under certain pressure and temperature conditions, form a solubility gap in the concentrations that are present.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wack (WO200050555) in view of Wack et al. (EP0587917).

In reference to claims 8-9, Wack '555 teaches a method for wet cleaning of objects which uses a cleaning fluid consisting of water and an organic solvent. In a defined range of concentrations and temperatures the cleaning fluid and water form a solution and outside the ranges present a miscibility gap. For wet cleaning the cleaning fluid is in the state of miscibility gap and contains the solvent at a concentration which at the temperature prevailing during wet cleaning is greater than the concentration at which the miscibility gap begins when the solvent is added to water. In reference to claim 10, the limitations are met since Wack teaches the same organic component as the instant specification. In reference to claim 11 and in view of the indefiniteness the limitations are met by the teachings of Wack. In reference to claims 12-13, refer to the abstract of Wack.

Wack '555 teaches the invention substantially as claimed with the exception of separating contaminants from the cleaning liquid, wherein separation occurs by filtration. Wack et al.'917 teach cleaning an object using a glycol ether mixture. In the

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embodiment of Fig. 1, Wack et al. teach a filter 22 for filtering contaminants from the cleaning mixture.

It would have been obvious to a person of ordinary skill in the art to have modified the method of Wack '555 to include a filter, as taught by Wack '917 for purposes of removing contaminants from the cleaning agent.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 8-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 70, 83, and 97 of copending Application No. 09/142452. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to cleaning objects by adjusting the solubility of the liquid cleaning composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Applicant is **reminded of their duty to disclose any and all related applications** since the obviousness-type double patenting rejection is based on a copending application by the same inventor.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wack et al. teach filtration and ultrasonics. Kuemin et al. teach a process for cleaning articles using an azeotrope. Sachdev et al. teach a reclamation of solvent. Ferber teaches a method and composition for cleaning articles. Wack et al. teach cleaning using an azeotrope mixture. Wack teaches cleaning using steam. Wack teaches the separation of two liquids.

14. In the IDS of 4/4/02, applicant cited DE19908434A1 and further indicated that a translation was provided. The examiner requests another copy of the translation since it is not included in the file of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 703-308-1876. The examiner can normally be reached on M-F, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 703-308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7719 for regular communications and 703-308-7719 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Sharidan Carrillo
Primary Examiner
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bsc
September 29, 2003